

Amendments to the Drawings

The attached drawing sheet includes changes to FIG. 9. This sheet replaces the original sheet including FIG. 9. FIG. 9 is a schematic illustration of a bracket placement method of the present invention with a bracket placement device of the present invention engaged with a coordinated bracket.

Support for the amendment to FIG. 9 is found in the originally filed FIG. 9, paragraph [48] as originally filed, as well as elsewhere in the originally filed specification, drawings and claims. The additional reference characters added to FIG. 9 identify features shown in FIG. 9, but not previously labeled. A description of these additional reference characters is found in paragraph [48] as amended.

Attachment: One Replacement Sheet.

REMARKS

A. Status of Claims.

1. Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-86 were presented for examination. In the Office Action mailed July 5, 2006, Claims 1-86 were rejected and/or objected to. By the foregoing Amendments, Claims 1, 7-10, 18-26, 35-36, 42-51, 68-71, and 79-86 have been amended and Claims 17, 41 and 78 have been cancelled. No new claims have been added. Thus, by the foregoing Amendments, claims 1-16, 18-40, 42-77 and 79-86 are pending in the application.

2. These amendments are believed not to introduce new matter and their entry is respectfully requested. Based upon the above Amendments and following Remarks, Applicant respectfully requests that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

B. Support for Amendments to Claims.

3. Support for the amendments to claims 1, 7-10, 18-26, 35-36, 42-51, 68-71, and 79-86 are found in the originally filed text, drawings and claims, as well as the above amendments to the text and drawings.

4. Specifically, support for the amendments to claims 1, 26, 51 is in paragraphs [25] and [48], and in the Figure 9, as originally filed, as well elsewhere in the originally filed specification, drawings and claims. Additional support for the amendments to claim 51 is found in the specification at paragraph [50] and in Fig. 11.

C. Support for Amendments to Specification.

5. Support for the amendments to paragraph [13] is found in paragraph [13] as originally filed and in FIGS. 8, 9, 10 and 11. The amendments to paragraph [13] provide the descriptions for FIGS. 8, 9, 10 and 11 in the correct order. Support for the amendments to paragraph [44] are found in the originally filed paragraph [44] and in FIGS. 8 and 9 as originally filed, as well as elsewhere in the originally filed specification, drawings and claims. Support for the amendments to paragraph [48] are found in the originally filed paragraphs [44] and [48] and in FIGS. 8 and 9 as originally filed, as well as elsewhere in the originally filed specification, drawings and claims. The amendments to paragraph [48] clarify what is shown in the embodiment of the present invention shown in FIG. 9.

D. Allowable Claims.

6. The Examiner is thanked for indicating that claims 9-10 and 70-71 would be allowable if rewritten in independent form, to include all limitations of the base claim and any intervening claims, as suggested by the Examiner.

E. Nonstatutory Double Patenting Rejection over Stockstill has been Rendered Moot by the Filing of the Accompanying Terminal Disclaimer.

7. At page 2 of the Office Action, Claims 1-86 are rejected on the basis of nonstatutory double patenting over claims 1-53 of U.S. Patent No. 6,682,344 to Stockstill (Stockstill '344). This rejection has been rendered moot by the filing of a Terminal Disclaimer with the present Amendment. Accordingly, Applicant requests that this rejection be reconsidered and withdrawn.

F. Potential Objection of Claims 51, 59-61, and 66-86 under 37 C.F.R. § 1.75 has been Rendered Moot by the Above Amendments to Claim 51.

8. At page 2, the Office Action states, “should claims 1-25 be found allowable, claims 51, 59-61, and 66-86 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.” This potential objection has been obviated by the above amendments to claim 51. Accordingly, Applicant requests that this rejection be reconsidered and withdrawn.

G. Rejection of Claims 17, 18, 41, 42, 78 and 79 under 35 U.S.C. § 112, Second Paragraph, have been Rendered Moot by Above Amendments to These Claims.

9. At page 3 of the Office Action, Claims 17, 18, 41, 42, 78 and 79 are rejected under 35 U.S.C. § 112, second paragraph. This rejection has been rendered moot by the above amendments to these claims. Accordingly, Applicant requests that this rejection be reconsidered and withdrawn.

H. Response to Rejection of Claims 1, 2, 7, 8, 12-14, 16-18, 26-54, 57-59, 68, 69, 73-75, and 77-79 under 35 U.S.C. § 102(b) over Pearlman.

10. Claims 1, 2, 7, 8, 12-14, 16-18, 26-54, 57-59, 68, 69, 73-75, and 77-79 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,134,208 to Pearlman (Pearlman). This rejection is respectfully traversed with respect to the claims as currently presented.

11. Independent claims 1, 26 and 51, as currently amended, claim, respectively, a bracket placement device, a method for placing a bracket using a bracket placement device, and a kit having one or more bracket placement devices, where the “bracket engaging means **only engages** [an] arch wire slot [of a bracket]” (emphasis added). However, Pearlman does not teach or suggest a “bracket engaging means [that] **only engages** [an] arch wire slot [of a bracket].” Pearlman’s embodiment shown in Figs. 1-7, doesn’t show a bracket engaging means engaging arch wire slot. Pearlman’s embodiment

shown in Figs. 8 and 9, shows a handle 80, including a bracket carrying means 85 that slidably receives (and engages) an entire bracket and not merely the arch wire slot of a bracket (*See* also, Pearlman, col. 4, lines 23-40). Accordingly, Pearlman cannot teach or suggest all of the features of Claims 1, 26 and 51, and, therefore, Claims 1, 26 and 51 are patentable over Pearlman.

12. Claims 2, 7, 8, 12-14, 16-18 depend directly or indirectly from Claim 1, and therefore are allowable for at least the same reasons that Claim 1 is allowable over Pearlman. Claims 27-50 depend directly or indirectly from Claim 26, and therefore are allowable for at least the same reasons that Claim 26 is allowable over Pearlman. Claims 52-54, 57-59, 68, 69, 73-75, and 77-79 depend directly or indirectly from Claim 51, and therefore are allowable for at least the same reasons that Claim 51 is allowable over Pearlman.

I. Response to Rejection of Claims 1, 2, 7, 8, 12-14, 17, 18, 26-54, 57-66, 68, 69, 73-75, 78, and 79 under §102(b) over Damon.

13. Claims 1, 2, 7, 8, 12-14, 17, 18, 26-54, 57-66, 68, 69, 73-75, 78, and 79 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,439,378 to Damon (Damon). This rejection is respectfully traversed with respect to the claims as currently presented.

14. Independent claims 1, 26 and 51 claims, as currently amended, claim, respectively, a bracket placement device, a method for placing a bracket using a bracket placement device, and a kit having one or more bracket placement devices, where the “bracket engaging means **only engages** [an] arch wire slot [of a bracket]” (emphasis added) and, where the bracket engaging means includes a contacting surface for abutting a contacting surface of the arch wire slot. However, Damon does not show a bracket engaging means that engages an arch wire slot of a bracket, much less one that **only** engages the arch wire slot of a bracket. For example, in Damon, the planar sides of a bracket frictionally engage the inner surfaces of a shield (Damon’s alleged “bracket engaging means”) that encompasses the bracket (*See* Damon, col. 9, lines 62-67 and Figs. 20 and 21).

Furthermore, because Damon does not teach or suggest engaging the arch wire slot of a bracket, Damon cannot teach or suggest an engaging means including a contacting surface for abutting the contacting surface of an arch wire slot. Accordingly, Damon cannot teach or suggest all of the features of Claims 1, 26 and 51, and, therefore, Claims 1, 26 and 51 are patentable over Damon.

15. Claims 2, 7, 8, 12-14, 17, 18 depend directly or indirectly from Claim 1, and therefore are allowable for at least the same reasons that Claim 1 is allowable over Damon. Claims 27-50 depend directly or indirectly from Claim 26, and therefore are allowable for at least the same reasons that Claim 26 is allowable over Damon. Claims 52-54, 57-66, 68, 69, 73-75, 78, and 79 depend directly or indirectly from Claim 51, and therefore are allowable for at least the same reasons that Claim 51 is allowable over Damon.

J. Response to Rejection of Claims 3-6, 11, 15, 21-25, 55, 56, 60-67, 72, 76, and 82-86 under §103(a) over Pearlman.

16. Claims 3-6, 11, 15, 21-25, 55, 56, 60-67, 72, 76, and 82-86 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pearlman alone. This rejection is respectfully traversed with respect to the claims as currently presented.

17. Claims 3-6, 11, 15, 21-25 depend directly or indirectly from Claim 1, and therefore are allowable for at least the same reasons that Claim 1 is allowable over Pearlman. Claims 55, 56, 60-67, 72, 76, and 82-86 depend directly or indirectly from Claim 51, and therefore are allowable for at least the same reasons that Claim 51 is allowable over Pearlman.

K. Response to Rejection of Claims 1-8, 11-25, 51, 52, 59-61, 66-69, 72-86 under §103(a) over Diamond.

18. Claims 1-8, 11-25, 51, 52, 59-61, 66-69, 72-86 are rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 4,474,555 to Diamond (Diamond). This rejection is respectfully traversed with respect to the claims as currently presented. The Office Action does not specify the patent number of the “Diamond” reference. However, Applicant notes that the sections of “Diamond” cited in the Office Action appear to correspond to U.S. Patent No. 4,474,555, cited in Applicant’s Information Disclosure Statement filed concurrently with the present application. Also, the general comments below regarding the patentability of 1-8, 11-25, 51, 52, 59-61, 66-69, 72-86 over Diamond, apply equally to both U.S. Patent No. 4,474,555 to Diamond and U.S. Patent No. 4,422,849 to Diamond, which was also cited in Applicant’s Information Disclosure Statement.

19. Independent claims 1 and 51, as currently amended, each claim the feature of a bracket placement device “used to place an orthodontic bracket on the *facial aspect* of a tooth” (emphasis added). However, Diamond only describes and shows positioning devices for lingual orthodontic brackets (*See*, Diamond, Title, Abstract, col. 1, lines 6-9, lines 49-55, col. 2, lines 42-44 and col. 3, line 12-15 of the specification and FIGS. 1, 2, 3, 4, 5, 6A, 6B, 7A, 7B, 8, 9A and 9B). Accordingly, Diamond cannot teach or suggest the claimed feature of a bracket placement device “used to place an orthodontic bracket on the *facial aspect* of a tooth,” and, therefore, Claims 1 and 51 are patentable over Diamond.

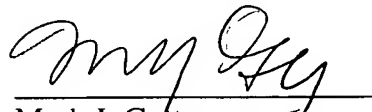
20. Claims 2-8, 11-25 depend directly or indirectly from Claim 1, and therefore are allowable for at least the same reasons that Claim 1 is allowable over Diamond. Claims 52, 59-61, 66-69, 72-86 depend directly or indirectly from Claim 51, and therefore are allowable for at least the same reasons that Claim 51 is allowable over Diamond.

L. Conclusion.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark J. Guttag at 703-591-2664, Ext. 2006.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,


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